

Remarks

Claims 1-17 are pending in this application and stand rejected. The Examiner made the rejection final. In light of the following remarks, the Applicant respectfully requests that the Examiner reconsider and withdraw the rejection.

PRIOR RESPONSE MAILED MAY 20, 2004

A response to a February 10, 2004 office action was filed on May 20, 2004. In the October 5 office action, the Examiner asserted that the Applicant's arguments in the May 20 response "fail to comply with 37 CFR 1.111 (b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The Applicant takes exception. In the May 20 response, independent claims 1, 13, and 16 were addressed directly. The combination of elements required by each claim was spelled out for the Examiner. The elements of each of those claims not taught or suggested by the Examiner's cited reference were also clearly pointed to the Examiner. Claims 2-12 were addressed as being patentable based on their dependence from Claim 1. Claims 14-16 were addressed as being patentable based on their dependence from Claim 13.

The Applicant's May 20 response was plainly not a general allegation that the claims define a patentable invention. The May 20 response specifically pointed out how the language of the claims patentably distinguishes them from the reference cited by the Examiner.

CLAIMS 1-5, 7-9, 12, AND 16:

Claims 1-5, 7-9, 12 and 16 were erroneously rejected under 35 U.S.C. §102 as being unpatentable over USPN 6,670,974 issued to McKnight. For a §102 rejection to be proper, a reference must teach or suggest the combination of elements required by a claim. A simple allegation that the reference teaches each element is not enough. It must be shown that the reference teaches the specific *combination* of elements. Imagine a claim requiring a combination of two elements – that is – two elements that interact with or are otherwise related to one another in a specified manner. One paragraph in a reference may teach

one element. Another unrelated paragraph may discuss the second element. However, without a showing that the reference teaches or suggests that the two elements are related in the manner specified by the claim, a rejection under § 102 is improper.

McKnight discloses a method and system in which a "persistent usage context . . . may be stored." McKnight, col. 2, lines 56-58. That usage context, for example, "may act to load previously accessed web sites into a user's web browser to enable the user to utilize the forward and backward buttons as if the [previous] web session were still active." McKnight, col. 3, lines 6-9.

Claim 1 is directed to a system for providing a history list of imaging compositions for a user and requires the following specific combination of elements:

1. a history list of the imaging compositions, each imaging composition having links to imaging data to be serviced as a single unit, the imaging data associated with the user through a user profile;
2. a composition store for storing said history list and said existing imaging compositions, wherein said composition store maintains said history list, and
3. a personal imaging repository providing for the composition store an exchange infrastructure between the imaging data associated with the user and available web services.

With respect to the first element listed above, the Examiner asserts that McKnight

1. col. 4, lines 43-44 teaches "a system that provides a history list of compositions;"
2. col. 9, lines 61-67 teaches "each imaging composition includes links to imaging data to be services [sic] as a single unit;" and
3. col. 7, line 32 et seq teaches "imaging data associated with a user through a user profile."

As indicated in the these sections cited by the Examiner, McKnight does teach a usage context that can provide a history of Items such as accessed web sites. However McKnight fails to teach the specific history list required by the first element of Claim 1. That is, McKnight does not teach a history list of imaging compositions where each imaging composition includes links to imaging data to be serviced as a single unit and where the imaging data is associated with a user through a user profile as required by Claim 1.

Contrary to the Examiner's assertion, the sections of McKnight, specifically col. 7, line 32 et seq, do not a teach history list of imaging compositions having links to imaging *data associated with a particular user through a user profile* in the manner required by Claim 1. The sections relied upon by the Examiner, specifically McKnight, col. 7, line 32 et seq, describe default settings that specify the color, window size, font type, time intervals displayed, and association representation format for a user interface window. Nothing in the sections cited tech or suggest teach a history list of imaging compositions that have links to imaging data *associated with a particular user through a user profile*. McKnight's default settings do not associate imaging data with a particular user or anything else for that matter. For at least this reason, Claim 1 is felt to distinguish over McKnight.

With respect to the second element of Claim 1, listed above, the Examiner asserts that McKnight, col. 3, lines 3-5 teaches a "composition store used for storing the list and compositions and maintaining the list." The cited section is taken from McKnight's summary and merely states the following:

In a preferred embodiment, saved usage contexts may be stored and selectively accessed on a user's information handling system. In another embodiment, the persistent usage context may act to load previously accessed sites into a user's web browser to enable the user to utilize the forward and backward buttons as if the web session were still active.

Nothing in this section even hints at a composition store that is responsible for storing a history list of imaging compositions as well as the imaging

compositions themselves in the manner required by Claim 1. For at least this additional reason, Claim 1 is felt to distinguish over McKnight.

The Examiner asserts that McKnight, col. 3, lines 1-3 teaches a "a personal imaging repository that provides, for a composition store, an exchange infrastructure between the imaging data associated with the user and available web service." The cited section is taken from a paragraph from McKnight's summary section that discloses a method and system in which a "persistent usage context . . . may be stored." McKnight, col. 2, lines 56-58. That usage context, for example, "may act to load previously accessed web sites into a user's web browser to enable the user to utilize the forward and backward buttons as if the [previous] web session were still active." McKnight, col. 3, lines 6-9.

Contrary to the Examiner's assertion, McKnight does not teach a personal imaging repository that provides, for a composition store, an exchange infrastructure between the imaging data associated with the user and available web services as required by the third limitation of Claim 1. Specifically, McKnight does not teach an exchange infrastructure between imaging data associated with a particular user and web services. For at least this additional reason, Claim 1 is felt to distinguish over McKnight.

Each of Claims 2-5 and 7-9 depend at least indirectly from Claim 1 and include all of the limitation of that base claim. For the reasons Claim 1 is patentable, so are Claims 2-5 and 7-9.

Claim 12 is directed to a method for providing a history list of imaging compositions and requires the following limitations:

1. receiving, on behalf of a user, a new imaging composition from a network service, the imaging composition having links to imaging data to be serviced as a single unit, the imaging data associated with the user through a user profile;
2. saving said new imaging composition to a composition store of a personal imaging repository associated with the user through the user profile;

3. adding said new imaging composition to a history list maintained by the composition store; and,
4. providing the history list to the user associated with the personal imaging repository responsive to a request for the history list.

For reasons discussed with respect to Claim 1, McKnight fails to the first limitation of Claim 12. Specifically, McKnight fails to teach receiving an imaging composition that includes links to imaging data associated with a particular user through a user profile. Moreover, McKnight fails to teach adding a history list to a composition store in which the imaging composition has been stored.

For at least these reasons, Claim 12 is felt to distinguish over McKnight. Claim 16 is directed to a computer program product having instructions for implementing the method steps of Claim 12. Claim 17 is directed to a system having means for implementing the method steps of Claim 12. For the same reasons Claim 12 is patentable, so are Claims 16 and 17.

CLAIMS 6, 10, 11, AND 13-15


Claim 6 was rejected under 35 U.S.C. §103 as being unpatentable over McKnight in view of USPN 5,903,889 issued to Hueriga. Claims 10, 11, and 14 were rejected under 35 U.S.C. § 103 as being unpatentable over McKnight in view of USPN 6,049,812 issued to Bertram. Claims 13 and 15 were rejected under 35 U.S.C. § 103 as being obvious over McKnight.

Claims 6, 10 and 11 each depend at least indirectly from Claim 1 and include all the limitations of that base Claim. Claims 13-15 each depend from Claim 12 and include all of the limitations of that base Claim. For the same reasons Claims 1 and 12 are patentable, so are Claims 6, 10, 11, and 13-15.

Conclusion

In view of the foregoing remarks and amendments, Applicant respectfully submits that Claims 1-17 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application and to pass the application to issue.

Respectfully submitted,
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